Craig S. Summers (Bar No. 108688)
craig.summers@kmob.com
Irfan A. Lateef (Bar No. 204004)
irfan.lateef@kmob.com
Thomas P. Krzeminski (Bar No. 213714)
thomas.krzeminski@kmob.com
Jonathan I. Detrixhe (Bar No. 258946)
jonathan.detrixhe@kmob.com
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
T: 949-760-0404; F: 949-760-9502

John W. Holcomb (Bar No. 172121)
john.holcomb@kmob.com
KNOBBE, MARTENS, OLSON & BEAR, LLP
3403 Tenth Street, Suite 700
Riverside, CA 92501
T: 951-781-9231; F: 949-760-9502

Attorneys for Defendant and Counterclaimant
TOSHIBA AMERICA CONSUMER
PRODUCTS, L.L.C.

IN THE UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

WESTERN DIVISION

GUARDIAN MEDIA TECHNOLOGIES, LTD., Plaintiff, v. TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C. Defendants.	Case No. CV09-0052 R (RCx) **DEFENDANT TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C.'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF NON-INFRINEMENT** Date: August 17, 2009 Time: 10:00 a.m. Ctrm. 8 Hon. Manuel L. Real
TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C., Counterclaimant, v. GUARDIAN MEDIA TECHNOLOGIES, LTD., Counterdefendant.	

TABLE OF CONTENTS

Page No.

I. INTRODUCTION 1

II. GUARDIAN HAS NOT RAISED ANY FACTUAL DISPUTE 2

III. GUARDIAN'S CONSTRUCTION OF "LOCAL TO" IS INCORRECT 3

A. Guardian's characterizations of the '160 file history are misleading, and do not support the conclusion that "local to" includes within 3

1. Guardian's reliance on the specification to construe "local to" supports TACP's construction 4

2. Guardian erroneously relies on the Examiner's statements in the July 17, 2008 Office Action that the Examiner subsequently corrected 4

3. The Examiner's rejection of a construction of "local to" to include "within" was clear and unambiguous 6

4. No weight should be given to Guardian's improper phone interview and post-confirmation Comments 8

5. The Examiner repeatedly rejected Guardian's arguments and amendments that "local to" include within a television 9

6. Guardian misrepresents the positions of a third-party as those of the Examiner 10

7. The Examiner is a person of ordinary skill in the art, and his opinion regarding claim construction is unrebutted 11

B. There is no specification support to construe "local to" to include within 12

1. The Examiner explicitly rejected Guardian's argument that a black signal generator "could be" within a television set 12

2. Guardian has not refuted TACP's common-sense example of the meaning of "local to" 14

3. Guardian's cancellation of "remote" from the claims does not mean that "local to" includes within a television set 14

TABLE OF CONTENTS
(*cont'd*)

Page No.

4. Guardian does not dispute that Fig. 1 illustrates the alternative video input originating from a location outside of the television 15

IV. GUARDIAN DOES NOT DISPUTE THAT UNDER TACP'S PROPOSED CONSTRUCTION, TACP DOES NOT LITERALLY INFRINGE 16

V. GUARDIAN HAS NOT SHOWN AND THUS IS PRECLUDED FROM SHOWING INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS 16

VI. CONCLUSION 20

TABLE OF AUTHORITIES

Page Nos.

Bell Atlantic Network Servs, Inc. v. Covad Commc'ns Group, Inc.,
262 F.3d 1258 (Fed. Cir. 2001) 15

Biogen, Inc. v. Berlex Labs., Inc.,
318 F.3d 1132 (Fed. Cir. 2003) 9

Biotec Biologische Naturverpackungen GmbH v. Biocorp, Inc.,
249 F.3d 1341 (Fed. Cir. 2001) 17

Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.,
541 F.3d 1115 (Fed. Cir. 2008) 19

Dayco Products, Inc. v Total Containment, Inc.,
258 F.3d 1317 (Fed. Cir. 2001) 13

Felix v. Am. Honda Motor Co.,
562 F.3d 1167 (Fed. Cir. 2009) 17

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,
535 U.S. 722, 122 S. Ct. 1831, 152 L. Ed. 2d 944 (2002) 19

Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.,
370 F.3d 1131 (Fed. Cir. 2004) 17

Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.,
554 F.3d 1010 (Fed. Cir. 2009) 15

Pall Corp. v. Hemasure Inc.,
181 F.3d 1305 (Fed. Cir. 1999) 18

Salazar v. Procter & Gamble Co.,
414 F.3d 1342 (Fed. Cir. 2005) 5, 6

Schriber-Schroth Co. v. Cleveland Trust Co.,
311 U.S. 211, 61 S. Ct. 235, 85 L. Ed. 132 (1940) 10

Stumbo v. Eastman Outdoors, Inc.,
508 F.3d 1358 (Fed. Cir. 2007) 16

OTHER AUTHORITIES

M.P.E.P. § 713.05 (8th ed. 2008) 8

M.P.E.P § 2287 8

M.P.E.P. § 1302.14 9

I. INTRODUCTION

Guardian's Opposition establishes that summary judgment is appropriate. Guardian has raised no factual issues in opposition. Thus, the only dispute is the correct construction of the term "local to" — an issue of law for the Court to decide. TACP contends that it means "in close proximity to, but not within." Guardian agrees that it means at least "in close proximity to." However, as the '160 patent and its file history establish, the term "local to" also means ***"but not within***." Under that construction, TACP cannot infringe the '160 patent either literally or under the doctrine of equivalents.

Guardian's Opposition fails to refute the intrinsic evidence that the "alternative source of video signal [that] is local to the receiving station" should not be interpreted "as within" the television set itself. Indeed, Guardian's Opposition does not even address key portions of the specification and file history. For example, Guardian does not contest that Fig. 1 illustrates that "alternative video input 4" that is "local to" the TV is provided from a location outside the TV. Nor does Guardian contest that the Examiner explicitly found that it would be "erroneous[]" to find that the black signal generator mentioned in the specification was within the television set itself. (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 517-18].)[1] Nor does Guardian contest the Examiner's conclusion that the '160 patent "does not appear to provide support for a recitation in which the 'alternative source of video signal' is recited as being located within a 'television set.'" (*Id.* at 518.)

Instead, Guardian relies on a misleading portrayal of the file history. For example, regarding the black signal generator, Guardian speculates that it ***could be*** located within a television set. But, Guardian's selective quotes from the file history on this issue ignore the Examiner's explicit conclusion that it would be "erroneous[]" to include the black signal generator as located within a television set itself. (*Id.* at 517-18.) In another example, Guardian represents a quoted portion of the file history as the words of the Examiner, even though the quoted material stated is the position of the reexamination Requestor, not the Examiner. (Opp'n at 14; December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 524].) In yet another example, Guardian selectively relies on a statement made by the Examiner in the July 17, 2008 Office Action, even though the Examiner unequivocally renounced the statement in his next communication. (Opp'n at 9; December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 517-18].)

---

[1] All references to exhibits are to the Detrixhe Declaration submitted with TACP's opening brief.

Guardian wishes the reexamination never occurred and begs that "this Court should proceed to determine the meaning of the term as if there had been no reexamination at all." (Opp'n at 11.) However, nothing in Guardian's Opposition can change the Examiner's unwavering conclusion that "local to" cannot be construed to mean "within" a television. Accordingly, the Court should construe "local to" to mean "in close proximity to, but not within" and grant summary judgment of non-infringement in favor of TACP.

II. GUARDIAN HAS NOT RAISED ANY FACTUAL DISPUTE

There is no factual dispute about TACP's televisions on this motion. Guardian has identified only the memory inside TACP's televisions as meeting the "local to" limitation. (Opp'n at 18.) Therefore, in its motion for summary judgment, TACP addressed Guardian's only infringement theory on this limitation. Guardian did not raise any factual disputes regarding this theory in its Opposition.

Moreover, TACP did not, as Guardian suggests, designate the 19LV610U television as a representative product. (Opp'n at 3-4.) It is Guardian who relied on that television as representative of all TACP televisions. (*See* Guardian's

Responses to TACP's First Set of Interrogatories, Response to Interrogatory No. 1 [Ex. 4 at 9-10, 20].) Regardless, TACP is obligated to address only what Guardian has relied upon for its infringement allegation — that memory within a TV meets the "local to" limitation.

Finally, Guardian wrongly accuses TACP of trying to "lessen its own burden of proving non-infringement." (Opp'n at 4.) As the plaintiff, Guardian alone bears the burden of proving infringement. Even on summary judgment, TACP's burden is simply to show the absence of evidence to support Guardian's infringement contention under the proper claim construction. Under TACP's proposed construction of "local to," Guardian has failed to show any evidence supporting infringement by TACP's TVs.

III. GUARDIAN'S CONSTRUCTION OF "LOCAL TO" IS INCORRECT

Guardian's construction of "local to" erroneously permits the alternative source of video signal to be within a television set. This construction is inconsistent with the '160 file history and specification.

A. Guardian's characterizations of the '160 file history are misleading, and do not support the conclusion that "local to" includes within

Guardian erroneously argues that sources of video signals "local to" a television include circuitry inside a television. (Opp'n at 18.) For support, Guardian relies on the Examiner's general statement that "local to" should be defined as being consistent with the specification. (*Id.* at 10.) TACP agrees that "local to" should be defined consistent with the specification. The specification, however, provides no support for the alternative source of video signal being located within a television set.

/ / /

/ / /

/ / /

/ / /

1. Guardian's reliance on the specification to construe "local to" supports TACP's construction

The Examiner explained the meaning of "consistent with the specification" when he stated that the specification "does not appear to provide support for a recitation in which the 'alternative source of video signal' is located within a 'television set.'" (October 1, 2007 Office Action [Ex. 3 at 254] [emphasis in original].) Guardian did not rebut or even address this finding by the Examiner, either in the reexamination or in its Opposition. Further, the Examiner stated with emphasis that "claims 3, 6, 7, 16, 19 and 20 should not be construed **as within the television set itself**." (December 4, 2008 Notice of Intent to Issue Ex Parte Reexamination Certificate [Ex. 3 at 518].) [emphasis in original].) Therefore, Guardian's primary argument that "local to" should be defined as consistent with the specification actually supports TACP's construction.

2. Guardian erroneously relies on the Examiner's statements in the July 17, 2008 Office Action that the Examiner subsequently corrected

Guardian also erroneously argues that the July 17, 2008 Office Action shows that the Examiner found "local to" to include within a television set. (Opp'n at 12.) Guardian, however, disregards that the Examiner, in the very next communication, expressly acknowledged that he had made a mistake and corrected himself in the December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate:

> The Examiner notes that the only local source of video disclosed by [the '160 patent] includes video disk or tape players and black signal generators. The Examiner also notes that [the '160 patent] does not disclose the exact location of the black signal generator other than the fact that it is local. The Examiner admits that

> previously (at least with respect to the previous advisory action) he had erroneously included the signal generator to be "within the television set" itself.

(*Id.* [Ex. 3 at 517-18] [emphasis in original].) Lest there be any doubt that it would be "erroneous[]" to include any "alternative source of video signal" as within the television — not just the black signal generator — the Examiner continued:

> The Examiner had previously noted on record that the instant disclosure, as originally filed, does not appear to provide support for a recitation in which the "alternative source of video signal" is recited as being located within a "television set" (see response mailed on October 1, 2007). Thus, contrary to the Patent Owner's statement (page 18 of the response filed on September 25, 2008), claims 3, 6, 7,16,19 and 20 should not be construed **as within the television set itself**.

(*Id.* at 518 [emphasis in original].) The foregoing establishes that Guardian is relying on an "erroneous" statement that the Examiner quickly rejected and corrected. Thus, Guardian's mischaracterization of the file history should be rejected.

After first relying on the Examiner's erroneous statement, Guardian then inconsistently argues the Examiner's opinions should be disregarded based on *Salazar*. (Opp'n at 6-7, 16-17.) In *Salazar*, the Federal Circuit rejected the district court's finding that statements first introduced by the Examiner in his Reasons for Allowance — regarding the meaning of a claim term that had never been at issue during prosecution — had "amended the claim." *See Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1345 (Fed. Cir. 2005). In contrast, the Examiner's statements in the Notice of Intent to Issue *Ex Parte* Reexamination Certificate — that "local to" should not be construed to include "within the television set itself" — was a clear and unmistakable reaffirmation of the same position he took early in the reexamination in rejecting the claims. (*See* October 1, 2007 Office Action [Ex. 3 at 253-54, 257].) Indeed, the Examiner specifically recognized the consistency of his construction of "local to" in the Notice of Intent to Issue *Ex Parte* Reexamination Certificate with his construction of "local to" in the October 1, 2007 Office Action rejections. (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 518].) Therefore, Guardian's reliance on the *Salazar* case is inapposite. In any event, even under *Salazar*, statements about a claim term made by an examiner during prosecution of an application are evidence of how one of skill in the art would understand the term. *Salazar*, 414 F.3d at 1345.

Guardian repeatedly argued during prosecution that "local to" included "within" a television set, but the Examiner steadfastly rejected this claim construction. The Examiner's first and last statement regarding the construction of "local to" was that it ***should not*** be construed as "within" a television set. Guardian's reliance on a single, isolated, and erroneous statement by the Examiner, a statement that the Examiner immediately corrected, is misplaced. (Opp'n at 9; December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 517-18].)

3. The Examiner's rejection of a construction of "local to" to include "within" was clear and unambiguous

Guardian next argues that the Examiner's damaging statements in the Notice of Intent to Issue *Ex Parte* Reexamination Certificate are "unclear." (Opp'n at 9.) Specifically, Guardian tries to rewrite the Examiner's statement that the confirmed claims "should not be construed **as within the television set itself**" into "the confirmed claims should be not construed as limited to within the television set itself." However, there is nothing "unclear" about the Examiner's statement at all. It is clear, unambiguous and unmistakable.

If the Examiner had intended to specify that the claims should not be construed as limited to within a television set — a statement nearly opposite in meaning — he would have done so. Moreover, if the Examiner had intended to include "within a television set" in the scope of "local to," he most certainly would not have stated in the immediately preceding sentence that the '160 patent "does not appear to provide support for a recitation in which the 'alternative source of video signal' is recited as being located within a 'television set.'" (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 518] [emphasis in original].)

Guardian attempts to explain the Examiner's damaging statements solely as a response to Guardian's arguments to distinguish Novak in view of Motoyama and to allegedly "preserve the validity" of the claims. (Opp'n at 8-9.) Guaridan's explanation is not persuasive. To distinguish the Novak reference, Guardian argued to the Examiner that the term "local to" requires the alternative source of video signal to be "within a television set itself." [Ex. 3 at 481.] The Examiner, however, expressly rejected, with emphasis, this construction: "claims 3, 6, 7, 16, 19 and 20 should not be construed **as within the television set itself**." [Ex. 3 at 518] [emphasis in original].[2]

---

[2] Guardian asserted that its construction of "local to" as meaning "within a television set itself" would be "unwarranted and unnecessary" if the patentability rejection was withdrawn. [Ex. 3 at 480-81.] The Examiner noted this assertion, but affirmed that term should not be construed as within the television set itself. [Ex. 3 at 518.] The Examiner went on to state that this term "***remains*** as being defined consistent with the disclosed description." (*Id.*) (emphasis added). As the Examiner had ***just stated***, the disclosed description does not provide support for a construction of "within a television set." (*Id.*) The Examiner then stated that he "relied on this claim interpretation" in evaluating evidence during reexamination, namely the Novak declaration submitted by Guardian. (*Id.*) Finally, the Examiner reiterated that he "did not accord the definition set by the Novak declaration ["within the television set itself"] in construing the claims but instead gave the defined definition and interpretation that was consistent with the [] Patent." (*Id.*) As the Examiner had just stated, because there was no support for a construction of "within a television set," the claims should not be construed as within the television set. (*Id.*)

There simply is no basis for Guardian's speculation that the Examiner somehow meant to include "within the television set itself" as part of the claim scope. To the contrary, the Examiner was clear and unambiguous about what he meant: "local to" should not be construed as "within the television set itself."

4. No weight should be given to Guardian's improper phone interview and post-confirmation Comments

Guardian next attempts to explain away the Examiner's damaging statements by arguing that an alleged phone call with the Examiner shows that the Examiner agreed with Guardian's construction of "local to." (Opp'n at 10.) The Court should reject Guardian's improper attempt to change the clear written record showing that the Examiner emphatically disagreed with Guardian's construction.

First, Guardian admits that its phone interview with the Examiner after the Notice of Intent had issued was "improper." (December 19, 2009 Comments on Statement of Reasons for Confirmation [Ex. 3 at 540].) Indeed, the PTO's rules explain that "no interview is permitted" after an application has been passed to issue. *See* M.P.E.P. § 713.05 (8th ed. 2008) (Appendix A). Nevertheless, Guardian ignored the Patent Office rules and made the phone call anyway. Guardian even characterized the improper phone call as an interview by submitting its "Patent Owner's Summary of an interview" through its Comments. (December 19, 2009 Comments on Statement of Reasons for Confirmation [Ex. 3 at 540].) Second, the Examiner did not consider, much less accept, Guardian's Comments. *See* M.P.E.P. § 2287 (Appendix C) ("Any 'Comments on Statement of Reasons for Patentability and/or Confirmation' which are received will be placed in the reexamination file, without comment.").

Guardian places much reliance on its post-confirmation Comments because the Examiner allegedly "did not refute" Guardian's "understanding" regarding the scope of "local to." (Opp'n at 10.) However, there was no obligation to and it would have been pointless for the Examiner to reaffirm, yet again, that "local to" did not include "within" a television set. He had been clear and unambiguous about that already.

Moreover, the Examiner's silence after Guardian submitted its Comments "**does not mean that the examiner agrees** with or acquiesces in the reasoning of such comments." (*See* M.P.E.P. § 1302.14 [emphasis added] (Appendix B).) Furthermore, a comment submitted by an Applicant after allowance "does not, indeed, cannot, change the examiner's Reasons for Allowance." *See Biogen, Inc. v. Berlex Labs.*, Inc., 318 F.3d 1132, 1139 (Fed. Cir. 2003). Guardian neither disputes this case law nor offers any justification why any weight should be given to its unilateral and self-serving Comments that the Examiner was not required to address. In short, Guardian improperly sought an interview with the Examiner, improperly attempted in its Comments to shift the burden to the Examiner to respond, and now is improperly using the Examiner's silence to assert agreement with its Comments. Therefore, the Court, like the Patent Office, should not give any weight to Guardian's Comments.

The final word in the file history is the Examiner's: the claims "should not be construed **as within the television set itself**." (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 518].)

5. The Examiner repeatedly rejected Guardian's arguments and amendments that "local to" include within a television

Guardian's argument that it never took the position that "local to" should be limited to "outside" a television is immaterial. (Opp'n at 10.) Though Guaridan disputed that "local to" should not mean "within" a television, the patent specification and prosecution history unambiguously support such a construction.

/ / /

There is no support in the ’160 specification for the “alternative source of video signal” being located within a television set. Moveover, the Examiner refused to interpret the claims as being located within a television set. Also, the Examiner rejected Guardian’s attempt to obtain claims where “the alternative source of video signal is ***local (i.e., internal to the television/receiving station)***” (July 28, 2006 Office Action Response [Ex. 3 at 122] [emphasis added]). After the Examiner rejected the amended claims, in part, as indefinite and found that the ’160 specification “*does not* appear to provide support for *a* recitation in which the ‘alternative source of video signal’ is recited as being located within a ‘television set’” (October 1, 2007 Office Action at p. 7 [Ex. 3 at 254] [emphasis in original]), Guardian abandoned these claims. If anything, the Examiner’s refusal to interpret “local to” as including “within” despite Guardian’s repeated arguments only highlights the importance that “local to” should not be construed to include “within” the television set itself. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 218, 61 S. Ct. 235, 238, 85 L. Ed. 132, 136 (1940) (“Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed.”).

6. Guardian misrepresents the positions of a third-party as those of the Examiner

Finally, Guardian’s reliance on the Examiner’s discussion of Chard to show that the Examiner understood “local to” to include “within” is misplaced. In its Opposition, Guardian quotes portions of the Notice of Intent in which the Examiner restates the position of the reexamination Requester. (Opp’n at 14.) As such, Guardian mischaracterizes the record by representing to this Court that

/ / /

the quoted portions were the views of the Examiner. For example, Guardian's Opposition states:

> [W]hile distinguishing a prior art reference (Chard, U.S. Patent No. 4,605,964) on other grounds, the examiner nonetheless found that the "display control unit 48 is 'local to the receiver.'" Chard '964 discloses "'a character generator and various control circuitry' that generates a video signal locally."

(Opp'n at 14.) However, reviewing the source of these quotations shows that the quoted material is actually the position of the third party that requested the reexamination, i.e. "the Requester" — *not* the Examiner:

> **In the request for reexamination filed on September 29, 2006, the Requester stated that** "Chard discloses a message display control unit 48 that "includes a character generator and various control circuitry", that generates a video signal locally. The input to the display control unit 48 is not a video signal, and the display control unit 48 is therefore the "source" of the alternative video signal and is local to the receiver.

(December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 524] [emphasis added].) The Examiner concluded that the alternative source in Chard was the same as the broadcast signal and therefore not "local to" the television. (*See id.*) Obviously, if the Examiner had adopted the position of the Requester, the Examiner never would have confirmed the claims. Guardian's reliance on the Requestor's invalidity argument to assert that the Examiner understood "local to" to include "within" is mistaken.

7. The Examiner is a person of ordinary skill in the art, and his opinion regarding claim construction is unrebutted

As Guardian pointed out, the Examiner is one of ordinary skill in the art. (Opp'n at 15.) The Examiner's opinion is the only evidence of what one of skill in the art would construe "local to" to mean. On multiple occasions, including his final communication, the Examiner expressed his opinion that the '160 patent "does not appear to provide support for a recitation in which the 'alternative source of video signal' is recited as being located within a 'television set.'" (October 1, 2007 Office Action [Ex. 3 at 254]; December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 518].) Guardian's Opposition never even addresses these statements. Furthermore, in confirming the claims, the Examiner made abundantly clear with emphasis that the claims "should not be construed **as within the television set itself**." (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 518].) Therefore, the Court similarly should construe "local to" to mean "in close proximity to, but not within," the television set.

Guardian casts the "but not within" portion of TACP's claim construction of "local to" as a "contrived extraneous limitation that Toshiba tries to append to the term." (Opp'n at 1.) These words are anything but contrived. Indeed, they are the words of the Examiner himself. Excluding these words from the construction would give Guardian exactly what the Examiner said it could not have.

B. There is no specification support to construe "local to" to include "within"

As shown in TACP's opening brief, the '160 specification and figures clearly confirm that "local to" cannot mean "within" a television.

1. The Examiner explicitly rejected Guardian's argument that a black signal generator "could be" within a television set

Guardian erroneously argues that the disclosed example of a black signal generator is an alternative signal source that ***could be*** located within a television. (Opp'n at 12). However, this argument ignores, indeed it directly contradicts, the Examiner's conclusion that it would be "erroneous[]" to include the black signal generator as within a television set itself. Guardian misguides the Court by not addressing this finding by the Examiner.

Guardian recognizes that the only examples of sources local to a television in the '160 patent specification are "a video disk or tape player" or "a black signal generator." (*Id.*) Guardian does not dispute that a video disk or tape player is not within a television set. Rather, Guardian argues only that a black signal generator could be within a television:

> The specification provides no requirement that a local source must be either inside *or* outside the physical boundaries of a television, but it likewise does not foreclose either configuration. Indeed, the reexamination examiner highlights this fact when he states "[the '160 patent] does not disclose the exact location of the black signal generator other than the fact that it is *local*." Thus, a black signal generator, if used as the alternative source of video signal, ***could be*** located in close proximity to the receiving station – i.e., within it, or near it.

(*Id.* [emphasis added]).[3]

Ironically, the Examiner reached the exact *opposite* conclusion. The Examiner immediately followed his statement that the '160 patent "does not disclose the exact location of the black signal generator other than the fact that it is local" by stating that "[t]he Examiner admits that previously (at least with respect to the previous advisory action) he had erroneously included the signal generator to be 'within the television set' itself." (December 4, 2008 Notice of Intent to Issue *Ex Parte* Reexamination Certificate [Ex. 3 at 517-18] [emphasis in original].) Guardian neither explains nor disputes the Examiner's conclusion that it would be "erroneous[]" to include the black signal generator as within the television set itself. Instead, Guardian advocates a claim construction on this motion that the Examiner expressly found "erroneous[]," without providing any explanation why the Examiner was wrong.

---

[3] Guardian invites impermissible speculation about the specification, not from the perspective of one of ordinary skill in the art, but from the litigation-inspired arguments of counsel. *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 1324 (Fed. Cir. 2001).

2. Guardian has not refuted TACP's common-sense example of the meaning of "local to"

Guardian's argument concerning the plain meaning of "local to" is itself erroneous. Guardian could not refute TACP's common sense example that a person who is "local to" a car is not inside the car. Instead, Guardian proposes a counterexample using a "Los Angeles 'local' business." (Opp'n at 12.) The term at issue, however, is "local ***to***." Guardian's example avoids the key relational preposition "to" in the claims. Therefore, Guardian's example is unhelpful.[4] As TACP previously stated, one does not use "local to" to mean "within."

3. Guardian's cancellation of "remote" from the claims does not mean that "local to" includes within a television set

Guardian's discussion regarding the cancellation of claim 2, which requires that the alternative signal source be "remote," is irrelevant. (Opp'n at 12.) Under the doctrine of claim differentiation, it can be inferred from dependent claim 2's recitation of "remote" that the "remote" limitation was not present in original claim 1, which was canceled. However, whether the "remote" limitation was present in original claim 1 does not inform whether an

---

[4] Guardian's resort to dictionary definitions (Opp'n at 13) are similarly unhelpful because they do not define "local ***to***."

"alternative source of video signal [that] is local to the receiving station," as recited by dependent claim 3, includes sources of video signal that are internal to a television set.

Furthermore, Guardian's assertion that "local to" should be interpreted as "not remote" is overly broad and erroneous. Guardian is entitled to claim no more than that which is supported by the specification. *Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.*, 554 F.3d 1010, 1018-19 (Fed. Cir. 2009) (refusing to construe "wound" beyond the scope of the patent specification). The '160 patent's disclosure of alternative sources of video signal that originate remotely provides no evidence that the '160 patent discloses an alternative source of video signal that is located within a television set. Instead, as understood by the Examiner, the '160 patent only provides support for alternative sources of video signal that are in close proximity to, but not within, a television set. Indeed, because the patentee used the term "local to" in the patent specification in a manner consistent with only a single meaning (in close proximity to, but not within), the patent has defined that term "by implication." *Bell Atlantic Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1271 (Fed. Cir. 2001).

4. Guardian does not dispute that Fig. 1 illustrates the alternative video input originating from a location outside of the television

Finally, Guardian has not disputed that Fig. 1 of the '160 patent illustrates "alternative video input 4" being provided from a location *outside* the television, just like the standard "video input 3" that corresponds to the blocked broadcast signal. Guardian's inability to contest this visual evidence is significant.

/ / /

/ / /

/ / /

/ / /

IV. GUARDIAN DOES NOT DISPUTE THAT UNDER TACP'S PROPOSED CONSTRUCTION, TACP DOES NOT LITERALLY INFRINGE

The proper construction of "local to" is "in close proximity to, but not within." Guardian presents no evidence or argument that TACP's TVs infringe under this construction. Thus, Guardian ***does not*** dispute that TACP's televisions do not literally infringe the confirmed claims of the '160 patent under this construction.[5]

V. GUARDIAN HAS NOT SHOWN AND THUS IS PRECLUDED FROM SHOWING INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

If the Court adopts TACP's proposed claim construction that "local to" means "in close proximity, but not within," there can be no infringement under the doctrine of equivalents. Guardian has not provided any evidence sufficient to overcome summary judgment regarding infringement under the doctrine of equivalents. To survive summary judgment of no infringement under the doctrine of equivalents, Guardian "must . . . provide particularized testimony and linking argument as to the 'insubstantiality of the differences' between the claimed invention and the accused device or process, or with respect to the function, way, result test when such evidence is presented to support a finding of infringement under the doctrine of equivalents." *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1365 (Fed. Cir. 2007). Furthermore, cursory conclusions that do not explain how differences are insubstantial are not sufficient to withstand summary judgment. *See id.*

/ / /

---

[5] Because TACP's motion is focused solely on the "local to" limitation, TACP does not concede that its televisions have an "alternative source of video signal" in memory or that other claim limitations are present in TACP's TVs.

Guardian has provided nothing more than a conclusory statement by its attorney that TACP's televisions infringe under the doctrine of equivalents by performing substantially the same function in substantially the same way to achieve substantially the same result. (Opp'n at 20.) Guardian did not provide any expert testimony, and arguments of counsel are not evidence. *Biotec Biologische Naturverpackungen GmbH v. Biocorp, Inc.*, 249 F.3d 1341, 1353 (Fed. Cir. 2001). Therefore, having failed to produce any evidence to the contrary, Guardian cannot defeat summary judgment of noninfringement under the doctrine of equivalents.

Moreover, Guardian is precluded by prosecution history estoppel from resorting to the doctrine of equivalents. In response, Guardian argues that it did not amend claim 3 and that it did not make any statements disavowing any scope of "local to." (Opp'n at 17.) However, Guardian arguments fundamentally misapprehend the effect of its decision to cancel the independent claims and to abandon certain claim amendments during reexamination.

Guardian's assertion that prosecution history estoppel cannot apply because claim 1 was amended and canceled — not claim 3 — is wrong. "'[W]hen a claim is rewritten from dependent into independent form and the original independent claim is cancelled . . . the surrendered subject matter is defined by the cancellation of independent claims that do not include a particular limitation and the rewriting into independent form of dependent claims that do include that limitation. Equivalents are presumptively not available with respect to that added limitation.'" *Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1183 (Fed. Cir. 2009). Similarly, "rewriting of dependent claims into independent form coupled with the cancellation of the original independent claims creates a presumption of prosecution history estoppel." *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1134 (Fed. Cir. 2004).

During reexamination, Guardian cancelled independent claim 1 and 14. (*See* December 3, 2007 Office Action Response [Ex. 3 at 331, 341].) Because claim 3 depends from claim 1 and claim 16 from claim 14, claims 3 and 16 were effectively rewritten into independent format upon cancellation of claims 1 and 14. Therefore, by cancelling these claims, Guardian acquiesced that claims 1 and 14 were not patentable. Another limitation was necessary. That limitation appears in claims 3 and 16. Accordingly, the cancellation of original independent claims 1 and 14 creates a presumption of prosecution history estoppel as to all the Asserted Claims.

Guardian simply ignores this argument, believing that it does not apply because claims 3 and 14 were not amended and are the same as the claims 3 and 14 that originally issued. (Opp'n at 17.) Guardian's assumption, however, is mistaken. "That the added claim was not amended during prosecution but was granted as filed ***does not*** preclude the application of prosecution history estoppel." *Pall Corp. v. Hemasure Inc.*, 181 F.3d 1305, 1312 (Fed. Cir. 1999) (emphasis added).

In its Opposition, Guardian did not submit any evidence or argument rebutting the presumption that resort to the doctrine of equivalents is precluded. Thus, equivalents are not available with respect to the added limitation presented in all Asserted Claims — in particular, the "local to" limitation.

TACP argued that Guardian is not permitted to revive, through the doctrine of equivalents, abandoned "in a television" and "local" limitations that Guardian unsuccessfully attempted to add during prosecution. (Mot. at 17-18.) Guardian responded by claiming that these amendments were to disavow alternative sources that were "remote" and had nothing to do with the scope of "local to." (Opp'n at 18-19.) Guardian, however, told the Patent Office something different. Guardian told the Patent Office that these amendments clarified that "the alternative source of video signal is ***local (i.e., internal to the***

television/receiving station)." (July 28, 2006 Office Action Response [Ex. 3 at 122] [emphasis added].) After the Examiner rejected the amended claims, in part, as indefinite and found that the '160 specification "*does not* appear to provide support for *a* recitation in which the 'alternative source of video signal' is recited as being located within a 'television set'" (October 1, 2007 Office Action at p. 7 [Ex. 3 at 254] [emphasis in original]), Guardian abandoned these claims.

Guardian is not allowed to recapture through the doctrine of equivalents in litigation what it could not obtain through the Patent Office. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-35, 122 S. Ct. 1831, 1838-39, 152 L. Ed. 2d 944 (2002). The Examiner's rejection of these claims indicated that the Examiner did not believe these claims could be patented. (*Id.*) Guaridan's cancellation of these claims is a concession that the "local to" limitations do not reach as far as the "in a television" claims that Guardian cancelled. (*Id.*) Therefore, Guardian is estopped from asserting in litigation that the "local to" limitation of the Asserted Claims covers "within" a television because the Patent Office rejected Guardian's attempt to include such a limitation during prosecution.

Finally, Guardian has not contested that permitting its theory of infringement under the doctrine of equivalents would impermissibly vitiate the "local to" limitation. The Examiner expressly excluded "within a television set" from the scope of the claims. To now include such scope through the doctrine of equivalents would impermissibly vitiate the claim limitation. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1129 (Fed. Cir. 2008).

/ / /

/ / /

/ / /

/ / /

VI. CONCLUSION

Guardian has raised no factual issues in Opposition. Thus, the only dispute is the correct construction of the term "local to" — an issue of law for the Court to decide. As the '160 patent and its file history establishes, the term "local to" means "***in close proximity to, but not within***." Under that construction, TACP cannot infringe the '160 patent either literally or under the doctrine of equivalents. Accordingly, the Court should grant TACP's Motion for Summary Judgment of Non-Infringement.

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 10, 2009

By: /s/Irfan A. Lateef
Craig S. Summers
John W. Holcomb
Irfan A. Lateef
Thomas P. Krzeminski
Jonathan I. Detrixhe
Attorneys for Defendant and Counterclaimant
TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C.

PROOF OF SERVICE

On August 10, 2009, I caused **DEFENDANT TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C.'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF NON-INFRINEMENT** to be electronically filed with the Clerk of the Court using the CM/ECF system which will send electronic notification of such filing to the following person(s):

Edward E. Castro, Jr.
ecasto@nbclaw.net
Brent N. Bumgardner
bbumgardner@nbclaw.net
Barry J. Bumgardner
barry@nbclaw.net
NELSON BUMGARDNER CASTRO, P.C.
3131 West 7th Street, Suite 300
Forth Worth, Texas 76107

John D. Klinedinst
jklinedinst@klinedinstlaw.com
Gregor A. Hensrude
ghensrude@klinedinstlaw.com
KLINEDINST PC
777 S. Figueroa St., 47th Floor
Los Angeles, CA 90017

In addition, I arranged to have a copy HAND DELIVERED on July 24, 2009 as follows:

HAND DELIVERY BY COURIER:

John D. Klinedinst
jklinedinst@klinedinstlaw.com
Gregor A. Hensrude
ghensrude@klinedinstlaw.com
KLINEDINST PC
777 S. Figueroa St., 47th Floor
Los Angeles, CA 90017

Executed on August 10, 2009 at Irvine, California.

/s/Irfan A. Lateef
Irfan A. Lateef
Attorneys for Defendant and Counterclaimant
TOSHIBA AMERICA CONSUMER PRODUCTS, L.L.C.
Email: irfan.lateef@kmob.com

7580714